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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,170	03/24/2000	Yoram Levanon	1268-094	2252

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EXAMINER	
GRAVINI, STEPHEN MICHAEL	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 04/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/534,170	Yoram LEVANON et al.
Examiner	**Art Unit**
Stephen M. Gravini	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 24, 2000*

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed system does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement are abstract ideas which can be performed mentally or naturally between persons without interaction of a physical structure. Collecting information is analogous to listening, analyzing and sorting profiles with producing advertisements is analogous to thinking of a response based on listening, and presenting an appropriate advertisement is analogous to responding to the listened data based on a thought response. Without a change in structure or manipulation of data, the independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement do not produce a useful, concrete and tangible result. The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement and claims depending from them, are not permitted under 35 USC 101 because it is non-statutory subject matter. Since

claims 2-7 depend upon claim 1, directly or indirectly, those claims are also rejected as depending upon a claim containing non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recited statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement are not enabled by the specification, because the specification does not discuss how the information is collected, how the profiles are analyzed and sorted, how the advertisements are produced, or how the advertisements are presented. Since the specification does not discuss these critical independently claimed elements of collecting, analyzing and sorting, producing, and presenting, the independently claimed inventions are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

invention. These claimed features are not enabled by the specification because examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention such that those skilled in the art could make or use the invention. Furthermore, claims 4 and 6 recite "or any other appropriate interactive media" which is not enabling from the specification, because no other appropriate interactive media is discussed. The specification merely recites the same language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of

the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 and 8 recite the broad recitation between three and thirty seven clusters and between people, and the claim also recites corresponding to all possible combinations and especially useful for dating services etc. respectively which is the narrower statement of the range/limitation.

7. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement are indefinite, because the specification does not provide an antecedent basis to show how the information is collected, how the profiles are analyzed and sorted, how the advertisements are produced, or how the advertisements are presented. Since the specification does not provide an antecedent basis for these critical independently claimed elements of collecting, analyzing and sorting, producing, and presenting, the independently claimed inventions are not described in the specification such that it overcomes a failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Furthermore, claims 4 and 6 recite "or any other appropriate interactive media" which lacks an antecedent basis from the specification and is indefinite, because no other appropriate interactive media is discussed. Finally claims 7 and 8 are rejected under 35

USC 112, second paragraph as being indefinite for containing a broad recitation followed by a narrower recitation. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
>
> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

9. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Day et al. (US 5,857,175) or Weinblatt (US 5,515,270) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kramer et al. (US 6,327,574) or Eldering (US 6,298,348) and are rejected under 35 U.S.C. 102(g) as being clearly anticipated by Lanzillo, jr. et al. (US 2002/0032602) or McKinley et al. (US 2002/0044743).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinblatt et al. (US 5,515,270). Weinblatt teaches the claimed invention, including the steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement, on the face of the patent. Weinblatt does not expressly show the analyzing and sorting of profiles into the clusters of survival, growth, and relaxation. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The analyzing and sorting steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031

(Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to analyze and sort profiles having any type of content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 97/21183, FTC Plans from the Dallas Morning News, US 5,799,157, and US 2001/0039510 teach consumer profile advertising.

US 5799157 + US B1 216129

14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-2100 are:

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Official	**(703) 746-7239**
Non-Official/Draft	**(703) 746-7240**

Steve Gravini

STEPHEN GRAVINI
PRIMARY EXAMINER

smg
April 25, 2002